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# In the Supreme Court
OF THE
# United States

OCTOBER TERM, 1944

**No. 434**

BAKER OIL TOOLS, INC. (a corporation),
REUBEN C. BAKER and T. SUTTER,
*Petitioners,*

vs.

ERD V. CROWELL,
*Respondent.*

## PETITION FOR WRIT OF CERTIORARI
## to the United States Circuit Court of Appeals
## for the Ninth Circuit
## and
## BRIEF IN SUPPORT THEREOF.

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## PETITION FOR WRIT OF CERTIORARI
## to the United States Circuit Court of Appeals for the Ninth Circuit.

*To the Honorable Harlan Fiske Stone, Chief Justice of the United States, and to the Honorable Associate Justices of the Supreme Court of the United States:*

Petitioners, Baker Oil Tools, Inc. (a corporation), Reuben C. Baker and T. Sutter, respectfully pray for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review a

judgment of that Court entered June 30, 1944. The Petition for Rehearing was denied on August 4, 1944.

In conformity with the provisions of Rule 38 of this Court, a certified copy of the record including the proceedings in and the opinion of the Circuit Court of Appeals in this case accompanies this petition (Opinion R. 139; Decree R. 149; Order denying petition for rehearing R. 150.)

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**SUMMARY STATEMENT OF THE MATTER INVOLVED.**

The judgment sought to be reviewed herein was rendered by the Circuit Court of Appeals for the Ninth Circuit reversing a judgment of the District Court of the United States for the Southern District of California, which latter Court had dismissed, for lack of jurisdiction, an action to determine the validity of a Letters Patent of the United States No. 1,748,007. (R. 103.)

There is no dispute as to the facts. There is involved here solely the important question of Federal law as to whether or not a District Court has jurisdiction of a suit under Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA), where the judgment if rendered would be advisory only and merely determine an assumed potential controversy between the parties which could arise only "if" in the future complainant entered the business of manufacturing or selling the patented devices, and upon the happen-

ing of that event "if" the patent owner then asserted some right under the patent against complainant.

The District Court entered a judgment dismissing the Complaint on the grounds that there was no actual, real or substantial controversy between the parties of sufficient immediacy and reality within the meaning of Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) to vest jurisdiction in the District Court to determine the matter.

The petitioner Baker Oil Tools, Inc. is the owner of United States Letters Patent No. 1,748,007 (R. 103), issued February 18, 1930 and expiring February 18, 1947. The respondent is an individual whom the District Court found as fact (R. 118-119) was not a manufacturer, had no machinery or facilities to manufacture the patented device, and had no salesmen or customers. The District Court also found as fact that respondent was not engaged (contrary to the allegation in the Complaint) in the manufacture of the patented devices.

The complainant, prior to the filing of the instant suit by him, made two devices (R. 47) (which are very simple in nature) which he contends infringe the patent which he prays to be declared invalid, but has not sold them. From respondent's own sworn statement (R. 98):

> "I am quite ready to believe that defendants never had, and do not have, any intention of prosecuting me for the small amount of four or five infringing devices which I have made prior to the institution of this suit."

it appears as fact that the respondent at the time of filing suit was in no fear that petitioner would assert the patent against him or involve him in litigation with respect to that patent for his trifling act of infringement and that no present, substantial or actual controversy existed.

Following the commission of this trifling infringing act and (according to his own sworn statement) without believing that he would be prosecuted for such act, respondent filed his Complaint for Declaratory Relief asking that petitioners' patent be declared invalid on various statutory grounds.

The Circuit Court of Appeals in its opinion (R. 139) holds that a justiciable issue is raised in the suit within the meaning of Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) because:

(a) of the presence of an actual controversy founded on the above set forth trifling infringing act of respondent and a different claim of infringment in a different and prior suit (for prior infringing acts of a different nature, which acts were enjoined in 1939) brought by the petitioner Baker Oil Tools, Inc. against respondent in the year 1936. In that suit respondent was sued on three patents of which the one here involved was one. Prior to the trial in the 1936 suit, the patent here involved was withdrawn, but a final judgment was entered in said suit decreeing that respondent had infringed, and an injunction issued against respondent pursuant to that judgment. (Respondent so admits R. 36-37.)

Thus, the issue raised in the prior suit as to respondent's right to build the devices there alleged to infringe was a different issue than attempted to be raised here and became *res adjudicata* as between these parties in 1939.

(b) of an assumed or inferred intention or desire on the part of respondent to sometime in the future engage in the manufacture and sale of the patented devices. To make out a controversy in this situation, the Circuit Court of Appeals apparently also assumes or infers that at such time, or if such an event happens, that the petitioner or patent owner would assert its patent against respondent.

It is the petitioners' contention, therefore, that no real issue is raised based upon any present or actual or substantial controversy, and that the only judgment which can be rendered in this suit by the District Court would be advisory only and determine an assumed potential controversy between the parties which could arise only if sometime in the future respondent entered in a bona fide fashion the business of manufacturing or selling the patented devices, and upon a further assumption that if he did so, that the petitioners would assert the patent against respondent. Thus, petitioners assert that the issue is not based on an existing state of facts, but entirely contingent on the happening of hypothetical future events and presents no "controversy" within the meaning of Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) warranting the issuance of a declaratory decree under such statute.

The District Court, upon petitioners' Motion for Summary Judgment (R. 60), dismissed the action for lack of jurisdiction on the ground that there was no actual or substantial controversy between the parties of sufficient immediacy and reality within the meaning of Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) to warrant the issuance of a declaratory judgment (R. 121, par. V). (The Opinion of the District Court appears at R. 110 and its Findings of Fact and Conclusions of Law at R. 117.)

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**JURISDICTION.**

Under Sec. 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U.S.C.A. Sec. 347 (a)), this Court has jurisdiction to review the judgment of the Circuit Court of Appeals herein. Judicial Code Sec. 41 (7) gives the District Courts of the United States original jurisdiction "of all suits at law or in equity arising under the patent, the copyright, and the trademark laws." Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) confers jurisdiction on the District Courts to entertain suits for declaratory judgment. The instant case is a suit for declaratory relief to declare a United States Letters Patent invalid. The Circuit Court of Appeals had jurisdiction of respondent's appeal (Judicial Code Sec. 129) from the decree of the District Court

dismissing the suit on the grounds of lack of jurisdiction.

The judgment of the Circuit Court of Appeals was entered June 30, 1944. A Petition for Rehearing was filed within thirty (30) days thereafter, and such petition was denied on August 4, 1944, and this petition is filed within three (3) months thereafter (28 U.S.C.A. 350; R.S. Sec. 1008 as amended, Sec. 6 Act of September 6, 1916, 39 Stat. 727.)

The discretionary power of this Court to grant a Writ of Certiorari is invoked upon the grounds set forth in Rule 38, subdivision 5 (b) of this Court, in that the Circuit Court of Appeals for the Ninth Circuit has decided a Federal question in a way probably in conflict with applicable decisions of this Court, to-wit, has interpreted Sec. 274d, as amended of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) as conferring jurisdiction on a District Court to render an advisory opinion as to the validity of a United States Letters Patent, when there is no present, real, actual or substantial controversy between the complainant and the patent owner.

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## QUESTIONS PRESENTED.

(1) Does Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) confer upon District Courts jurisdiction to render advisory opinions as to the validity of a United States Letters Patent?

(2) Does Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) confer on District Courts jurisdiction to entertain suits to determine the validity of United States Letters Patent, where the alleged controversy is based upon an assumption that the complainant may subsequently engage in acts which would infringe the patent if valid, and upon the further assumption that at such time the patent owner will improperly, or otherwise, assert its rights under the patent against the complainant?

---

**REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.**

The Circuit Court of Appeals in the instant case decides an important question of Federal law, to-wit, the question of the authority of a District Court under Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) to render an advisory opinion as to the validity of a Letters Patent of the United States in a way probably in conflict with the applicable decisions of this Court, to-wit, the cases of:

*St. Pierre v. United States,* 319 U. S. 41, 63 S. Ct. 910;

*United States v. Appalachian Electric Power Co.,* 311 U. S. 377, 61 S. Ct. 291, 85 L. ed. 243;

*Ashwander v. Tennessee Valley Authority,* 297 U. S. 288, 56 S. Ct. 466, 80 L. ed. 688.

That to permit the decision of the Circuit Court of Appeals in the instant case to stand would likely result in confusion and uncertainty and lack of uniformity in the various Circuits in the interpretation of Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) on the question of what constitutes an "actual controversy" within the meaning of said act sufficient to vest jurisdiction in a District Court to determine the validity of a United States Letters Patent.

Wherefore, your petitioners respectfully pray that a Writ of Certiorari be issued under the Seal of this Court, directed to the United States Circuit Court of Appeals for the Ninth Circuit, commanding that Court to certify and send to this Court on a day to be designated a full and complete transcript of the record and all proceedings of said Circuit Court of Appeals had on this cause to the end that this cause may be reviewed and determined by this Court that the judgment of said Circuit Court of Appeals as to the matters raised herein be reversed, and that your petitioners may be granted such other and further relief as may seem just and proper.

Dated, Oakland, California,
August 28, 1944.

Respectfully submitted,
ALAN W. DAVIDSON,
*Attorney for Petitioners.*

OSCAR ALVIN MELLIN,
*Of Counsel.*

CERTIFICATE OF COUNSEL.

I hereby certify that the foregoing petition for Writ of Certiorari is not interposed for delay and in my judgment the same is well founded.

Dated, Oakland, California,
August 28, 1944.

ALAN W. DAVIDSON,
*Attorney for Petitioners.*

# In the Supreme Court
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No.

BAKER OIL TOOLS, INC. (a corporation),
REUBEN C. BAKER and T. SUTTER,
*Petitioners,*

vs.

ERD V. CROWELL,
*Respondent.*

## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

### OPINION OF THE COURT BELOW.

The opinion of the Circuit Court of Appeals in the instant case is found in R. 139. The Findings of Fact and Conclusions of Law entered by the District Court are at R. 117. The Opinion of the District Court appears at R. 110.

## JURISDICTION OF THIS COURT.

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the act of February 13, 1925; 28 USCA, Sec. 347 (a). The date of the decree sought to be reviewed is June 30, 1944 (R. 149), but the petition for rehearing was not denied until August 4, 1944 (R. 150), and this petition is filed within three months thereafter (28 USCA 350; R.S. Sec. 1008 as amended, Sec. 6 act of September 6, 1916, 39 Stat. 727). The discretionary power of this Court to grant a Writ of Certiorari is invoked upon the grounds set forth in Rule 38, subdivision 5 (b) of the rules of this Court.

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## STATEMENT OF FACTS.

This is a suit brought by respondent under the patent laws of the United States and under Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA), praying a declaration that petitioners' Letters Patent No. 1,748,007 (R. 103) is invalid.

After the filing of the complaint (R. 2) and the answer (R. 22) in the District Court, petitioners under Rule 56 Federal Rules of Civil Procedure moved (R. 60) for summary judgment of dismissal of the action on the ground that there was no actual, real or substantial controversy between the parties of sufficient immediacy and reality within the meaning of Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec.

400, FCA) to vest jurisdiction in the District Court to determine the matter. The motion was granted on that ground (Opinion R. 110) and a judgment (R. 123) was entered pursuant thereto. From this judgment respondent appealed. The Circuit Court of Appeals reversed the judgment.

The facts on which the suit is based are undisputed. Respondent admitted in his deposition (R. 47) that he had made but two infringing devices prior to his instituting the suit; and the District Court found as fact (R. 118) that he was not a manufacturer, had no customers, employees or salesmen, *and had no facilities for manufacturing.* The District Court further found that respondent *was not engaged in manufacturing the patented devices.*

As to a present and existing controversy, respondent admits (R. 37) that petitioners have not called his attention to the patent as to the two infringing acts alleged, or threatened him with suit therefor, but on the contrary respondent states that he believes that the petitioners have no intention of asserting any rights under this patent for those specific acts. Respondent states (R. 98):

> "I am quite ready to believe that defendants never had, and do not have, any intention of prosecuting me for the small amount of four or five (his deposition R. 47 says 2) infringing devices which I have made prior to the institution of this suit." (Insert ours.)

Despite the above, the Circuit Court of Appeals to raise a fictitious present "actual controversy" points

to a prior totally different infringement action filed against respondent in 1936 by petitioner Baker Oil Tools, Inc. In that suit three patents were relied upon, including the one at bar. The latter and one other were withdrawn from the suit without prejudice prior to the entry of a final decree and the issuance of a permanent injunction in the year 1939 in said suit against respondent. The Circuit Court of Appeals relied upon the bringing of that suit as a present or existing threat of suit as follows (R. 142):

> "Insofar as a claim of infringement by the patentee may be necessary to make an actual controversy, we hold that there was such a claim at least up to the dismissal without prejudice of the suit against appellant on January 20, 1939, less than four years before the filing of the complaint in the instant suit."

The suit referred to by the Circuit Court of Appeals is the one referred to above, and the matter there litigated is *res adjudicata* as between the parties.

As to the future, respondent asserts under oath (R. 98) that *if he succeeds in successfully competing in the manufacture and sale of the device,* he believes petitioners will in the future bring suit for infringement. Respondent's statement (R. 98):

> "that if I succeed in successfully competing in the manufacture and sale of said devices and have built up large potential damages that said defendant Baker Oil Tools, Inc., will institute such suit."

The Circuit Court of Appeals recognizes this potential future jeopardy as a proper basis for a declaratory suit under the act by stating (R. 143):

> "The purposes of that act are best served if a four-time infringer or a one-time infringer intending to challenge the validity of the patent, does not commit the economic waste of building or engaging another to build a plant to manufacture the alleged patented device before having determined the validity of the patent."

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**SPECIFICATION OF ERROR.**

The Circuit Court of Appeals erred in disregarding the applicable decisions of this Court by so construing Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA) as to give a United States District Court jurisdiction of an action to determine the validity of a Letters Patent of the United States, where the controversy is not a present one but purely potential, and a judgment, if rendered, would be advisory only and would merely determine an assumed potential controversy between the parties.

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**ARGUMENT.**

**THERE IS NO PRESENT AND EXISTING CONTROVERSY BETWEEN THE PARTIES.**

Although the respondent has alleged the making of two devices (R. 47) which would infringe the patent, if valid, he states under oath (R. 98):

> "I am quite ready to believe that defendants never had, and do not have, any intention of prosecuting me for the small amount of four or five (his deposition R. 47 says 2) infringing devices which I have made prior to the institution of this suit." (Insert ours.)

The above statement of respondent, coupled with the finding of fact of the District Court that respondent is not engaged in the manufacture and sale of the devices (R. 118) and has no facilities for so doing, clearly shows the lack of a presently existing controversy. Certainly, it does not make out a state of fact indicating "imminent" and "inevitable" litigation.

In construing declaratory judgment statutes the great weight of authority is to the effect that the facts upon which a legal decision is demanded must have accrued, for the principle of a declaratory judgment is that it declares the existing law on an existing state of facts. (*Ashwander v. Tennessee Valley Authority,* 297 U. S. 288, 56 S. Ct. 466, 80 L.ed. 688.) The danger or dilemma of the plaintiff must be present, not contingent on the happening of hypothetical future events and the threat to his position must be actual and genuine and not merely possible or remote. Thus, as to the facts at the time of the suit at bar, the respondent was in no present jeopardy or fear of present litigation, but merely in fear of some potential litigation in the distant future. Respondent's own sworn statement (R. 98) as above totally refutes the Circuit Court of Appeals holding that there is a present and actual controversy.

In fact respondent's own statement confirms that the declaration is requested on a potential and assumed controversy. At R. 98 respondent states:

> "but I do not doubt for a moment that after I have continued, until near the end of the term of said Letters Patent, and defendants have nothing to lose by an infringement suit, that *if* I succeed in successfully competing in the manufacture and sale of said devices and have built up large potential damages that said defendant Baker Oil Tools, Inc., will institute such suit." (Italics ours.)

Thus, the real state of fact depended upon to raise a justiciable controversy is based upon an assumed potential condition; i.e. *if* the respondent engages in the business of the patented devices and *if* he succeeds in successfully competing in that business, and a further assumption that in such event the patent owner will assert the patent against respondent.

The real reason for the suit is palpably clear, and it is that respondent wishes an advisory opinion as to the validity of the patent, so that if the Court declares it invalid, he may decide whether or not to enter the business of making the devices. The making of the two simple devices prior to the institution of the suit was obviously either experimental or an attempt to raise a colorable present issue.

Petitioners, therefore, contend that the respondent does not have sufficient legal, pecuniary or personal interest to institute a proceeding which is worthy of judicial relief. He does not contend that he or his

business is in present jeopardy. The facts clearly show that the potential conflict is not sufficiently complete, mature, approximate or ripe to warrant the grant of judicial relief. The interest of the respondent must be present and not contingent. (*Ashwander v. Tennessee Valley Authority* (supra), 297 U. S. 288, 56 S. Ct. 466, 80 L.ed. 688.)

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**DIRECT CONFLICT BETWEEN THIS CASE AND THE CASE OF ASHWANDER v. TENNESSEE VALLEY AUTHORITY, 297 U. S. 288 (SUPRA).**

In the case at bar the Circuit Court of Appeals holds that one who is not in the business of the patented devices and has no facilities for manfacturing a patented device can challenge the validity of a patent by simply making one of the devices and alleging that the same infringes the patent. The Circuit Court of Appeals holds that one can rely upon the statutory notice as a threat of an infringement suit and thus create a "controversy", provided that the challenger alleges some intent or desire of entering in the future in the business of manufacturing or having manufactured such patented devices. The decisive ruling of the Circuit Court of Appeals on this point is at R. 143 and is as follows:

> "Appellant's making of the several infringing devices and his intent to cause the production of more, evidenced by his understanding with a friendly company to supply him with the necessary material, are sufficient to invoke the right to sue the patent owner under the declaratory judg-

ment act. The purposes of that act are best served if a four-time infringer or a one-time infringer intending to challenge the validity of the patent does not commit the economic waste of building or engaging another to build a plant to manufacture the alleged patented device before having determined the validity of the patent."

From respondent's own statement (R. 98), he is in no fear of litigation for his past acts, but is merely in fear that a suit may be brought against him, *if he successfully engages in the business of the patented device sometime in the future,* at which time he believes he will be sued for infringement. Thus, the conclusion is inescapable that what respondent actually desires from the Court, and what the Circuit Court of Appeals believes he is entitled to, is an advisory opinion as to the validity of the patent so that he can decide whether or not he wishes to go into the business of manufacturing the patented device.

This decision by the Circuit Court of Appeals is in direct conflict with many cases decided by this Court to the end that judicial power does not extend to the giving of advisory opinions or to the determination of abstract questions and claims based upon merely assumed potential invasions of rights.

*Waite v. Dowley,* 94 U. S. 527, 24 L. ed. 181;
*Richmond F. & P. R. Co. v. Louisa R. Co.,* 54 U. S. 71, 13 How. 71, 14 L. ed. 55;
*St. Pierre v. United States,* 319 U. S. 41, 63 S. Ct. 910;

*United States v. Appalachian Electric Power Co.*, 311 U. S. 377, 61 S. Ct. 291, 85 L. ed. 243;

*Arizona v. California*, 283 U. S. 423, 51 S. Ct. 522, 75 L. ed. 1154;

*Ashwander v. Tennessee Valley Authority* (supra), 297 U. S. 288, 56 S. Ct. 466, 80 L. ed. 688.

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**CONFUSION BETWEEN THE CIRCUITS WILL UNDOUBTEDLY ARISE IF THIS COURT DOES NOT EXERCISE ITS SUPERVISORY POWER IN THIS CASE.**

This Court has not specifically passed upon the exact legal question of what legal interest a member of the public must have before he may come into Court and challenge the validity of a United States Letters Patent. In principle, however, it has decided this question on the basis of advisory opinions and rendering an opinion on assumed potential invasion of rights, and the instant decision by the Circuit Court of Appeals is in direct conflict with those latter decisions by this Court.

The underlying change in the law by the adoption of the declaratory judgments act was procedural only and it had a beneficial effect as far as patents were concerned. Manufacturers and dealers producing and selling devices somewhat like a patented one did, prior to the adoption of the act, occasionally meet with difficulty. The patentee could, without bringing suit, publicly claim infringement and threaten to sue the competitor, with no opportunity on the part

of the competitor to submit the matter for judicial decision unless the patentee might decide to bring an infringement action. However, it does not seem that Congress had intended to substitute one evil for another. If the Circuit Court of Appeals decision in the instant case is permitted to stand as law, any member of the public, by making one of the patented devices and without necessarily having any intention, means or facilities for producing more or even entering into the business, can challenge the validity of a patentee's patent and compel him to litigate it regardless of the absence of an actual or substantial controversy. This would certainly result in the Courts giving advisory opinions as to the validity of patents.

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**CONCLUSION.**

We respectfully submit that the decisive ruling of the Circuit Court of Appeals in the instant case is in direct conflict with applicable decisions of this Court; that this question is a Federal question of considerable importance with regard to the patent laws of the United States, and with regard to Sec. 274d, as amended, of the Judicial Code (Federal Declaratory Judgments Act, Title 28, Sec. 400, FCA); and that because of the conflict and the importance of the question, the instant case is one calling for the exercise of the supervisory powers of this Court to grant a Writ of Certiorari under Rule 38, subdivision 5(b) of the rules of this Court, and the petitioners, therefore, respectfully pray that a Writ of Certiorari be

granted so that this Court may review the decision of the Circuit Court of Appeals for the Ninth Circuit and finally reverse it.

Dated, Oakland, California,
August 28, 1944.

Respectfully submitted,
ALAN W. DAVIDSON,
*Attorney for Petitioners.*

OSCAR ALVIN MELLIN,
*Of Counsel.*